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Apostol Konomi

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EXAMINER

PAYNE, SHARON E

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GROUP 2800

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/824,966
Filing Date: April 03, 2001
Appellant(s): KONOMI, APOSTOL

Melissa Patangia
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 March 2004.

(1) *Real Party in Interest*

The brief does not contain a statement identifying the Real Party in Interest. Therefore, it is presumed that the party named in the caption of the brief is the Real Party in Interest, i.e., the owner at the time the brief was filed. The Board, however, may exercise its discretion to require an explicit statement as to the Real Party in Interest.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because only one independent claim exists (claim 1). Since the case only has one independent claim, the claims stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

1,931,577 EASTERDAY 10-1933

5,625,968 ASHALL 5-1997

5,283,673 MURASE ET AL. 2-1994

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 9-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Easterday et al. (U.S. Patent 1,931,577) in view of Ashall (U.S. Patent 5,625,968).

Regarding claim 1, Easterday et al. discloses two display signage panels (reference number 18) having a desired design face (Figs. 1 and 2); a light source (reference number 14) offset from and behind the two display signage panels (Fig. 2); a light directing panel (reflector, reference number 26) located behind at least one of the two display signage panels (Fig. 2), whereby light directly incident on the at least one display signage from the light source and redirected light from the light directing panel backlight and illuminate the two display signage panels, or at least one display signage panel (Figs. 1 and 2). Easterday does not disclose a second light source.

Ashall discloses an illuminated sign like that of Easterday providing a second light source for additional light (column 2, lines 15-17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the second light source of Ashall in the apparatus of Easterday et al. for providing additional light.

Concerning claim 2, Easterday et al. does not specifically disclose the dimensions of the box, the thickness in particular.

Determining the thickness of a lighting display is considered to be an obvious variation in design (see M.P.E.P. 2144.04; *In Re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955)). It would have been obvious to one of ordinary skill in the art to determine an overall thickness in the Easterday et al. reference for distributing light as desired.

Regarding claim 3, Easterday et al. does not disclose signage panels constructed of two sheets plastic that hold a picture between them. Ashall discloses the use of plastic sheets

(column 2, lines 48-49) and signage panels constructed of two sheets (reference numbers 16 and 17, Fig. 2b).

Using sheets with a width of 2 mm each is considered to be an obvious variation in design (see M.P.E.P. 2144.04, *In Re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955)). It would have been obvious for one skilled in the art to use two plastic sheets with a width of 2 mm for holding the signage in the Easterday et al. reference.

Concerning claim 4, Easterday et al. discloses a light-directing panel that comprises two sides (Fig. 2).

Regarding claim 5, Easterday et al. discloses a light-directing panel comprising four sides (Fig. 2). (Each inclined face of the light-directing panel has a front and a back.)

Concerning claim 6, Easterday et al. does not disclose at least a portion of the light-directing panel being substantially transparent. Ashall discloses a light-directing panel (reference number 10) that is substantially transparent for allowing light incident thereon to pass through the light-directing panel and toward the display signage panel (column 2, lines 65-67).

Concerning claim 7, Easterday et al. discloses a light-directing panel that is completely non-transparent (reference number 26, reflector).

Regarding claim 9, Easterday et al. discloses two display signage panels having a desired design face (reference number 18), a first display signage panel and a second display signage panel (Fig. 2, reference number 18 on each side), wherein the light source (reference number 14) is offset from and located substantially equidistantly from the first display signage panel and the second display signage panel (Fig. 2), and the light-directing panel being located substantially equidistantly between the two display signage panels (Fig. 2) whereby light directly incident on each display signage panel from the light source and redirected light from the light-

directing panel backlight and illuminate the first display signage panel and the second display signage panel (Fig. 2). Easterday does not disclose the second light source.

Ashall discloses the second light source for the reasons discussed in the analysis of claim 1.

Concerning claim 10, Easterday et al. discloses the two display signage panels (reference number 18) having the same height and length (Figs. 1 and 2).

Regarding claim 11, Easterday et al. does not disclose signage panels that are as tall as the glass portion of the two light sources.

Ashall discloses the two display signage panels being substantially as tall as the glass portion of the two light sources (Fig. 1, column 2 in lines 16-17, column 2 in lines 43-49). The glass portion of the light source in Fig. 1 is shown as being the same width as the display signage panel, and the specification indicates that a light may be used on another side, which may be a vertical side (column 2, lines 16-17). To implement this invention, the glass portion of any lights on the vertical side would have to be the same length as the vertical side.

Concerning claim 12, Easterday discloses a light-directing panel (reference number 26) that is substantially the same height as the two display signage panels (reference number 18, Fig. 2).

Regarding claim 13, Easterday does not disclose a light-directing panel that has substantially the same height as the glass portion of the two light sources.

Ashall discloses the light-directing panel that has substantially the same height as the glass portion of the two light sources (Fig. 1, column 2 in lines 16-17, column 2 in lines 43-49). The glass portion of the light source in Fig. 1 is shown as being the same width as the light-directing panel, and the specification indicates that a light may be used on another side, which

may be a vertical side (column 2, lines 16-17). To implement this invention the glass portion of any lights on the vertical side would have to be the same length as the vertical side.

Concerning claim 14, Easterday et al. discloses a housing (reference number 10) for supporting two display signage panels or at least one display signage panel (Figs. 1 and 2).

Regarding claim 15, Easterday et al. discloses the interior of the housing is at least partially reflective surface for reflectively directing light toward the two display signage panels or at least one display signage panel (page 1, lines 78-88).

Concerning claim 16, Easterday et al. discloses a housing that is constructed of a rigid material (page 1, lines 60-61).

Regarding claim 17, Easterday discloses a housing that further houses electrical circuitry associated with powering the double-sided edge lighting-type display sign, wherein the electrical circuitry is configured not to interfere with the backlighting and illumination of the two display signage panels (Fig. 1). (The wire, reference number 15, is the electrical circuitry.)

For purposes of this office action, claim 19 is being analyzed as if it depends on claim 1 instead of cancelled claim 18. Regarding claim 19, Easterday does not disclose fluorescent bulbs. Ashall discloses the light sources comprising elongated fluorescent bulbs (column 2, lines 50-55, Fig. 1).

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Easterday et al. in view of Ashall as applied to claims 4 and 5 above, and further in view of Murase et al. (U.S. Patent 5,283,673).

Regarding claim 8, Easterday et al. does not disclose the distance between two light sources being less than 65% of the length of the two light sources. Murase et al. discloses the

distance between the two light sources (reference number 14) being less than 65% of the length of the two light sources (Fig. 6) to illuminate the display.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a plurality of light sources have the same distance between each other as those in Murase et al. reference to illuminate the display sufficiently in the Easterday et al. reference.

(11) Response to Argument

Issue 1—Whether claims 1-7, 9-17 and 19 are unpatentable over Easterday et al. in view of Ashall under 35 USC 103(a)?

Claim 1

Appellant argues that the Appellant's invention varies significantly from the apparatuses disclosed in Easterday and Ashall. More specifically, the Appellant contends that Ashall really does not disclose the use of two light sources, because the specification of Ashall suggests the use of a second light source on larger signs. What Appellant really has done is admit that Ashall discloses the use of two light sources on a sign. The fact that Ashall does not disclose the use of two light sources on smaller signs is immaterial, because nothing in claim 1 requires that the sign be small. Furthermore, Appellant argues that neither Easterday nor Ashall disclose the reflecting panel configuration disclosed in the present application. The problem with Appellant's argument is that the claim does not require that configuration. The Appellant wants the Examiner to read in limitations from the specification into the claim, which is not permissible. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant also argues that Easterday and Ashall teach away from the present invention, but the Appellant fails to show where the references do so. As stated earlier the fact that two light sources are used on a large sign in Ashall does not teach away from using two light

sources on a sign. Furthermore, claim 1 does not require a small sign, so nothing in Easterday or Ashall teaches away from the combination of references to defeat claim 1.

Appellant suggests that Easterday and Ashall cannot be used to defeat claim 1 because they exhibit the problems inherent in the prior art. Even if this assertion is true, it is immaterial to the allowability of claim 1. The differences between the prior art and the present application must be present in the claim and not just the specification. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant further argues that the matrix of dots in Ashall teaches away from the reflective mechanisms used in the present invention. Using one reflective mechanism does not teach away from using another. It teaches the use of a reflective mechanism. As stated earlier the reflective mechanisms of the present invention need to be more clearly described in claim 1 to make claim 1 allowable.

In addition, Appellant argues that Easterday and Ashall cannot be combined because the combination does not yield a proper working invention. To the contrary, a reasonable expectation of success exists as required by M.P.E.P. 2141. Adding a second light source to the Easterday reference provides more light. It is reasonable to expect that the addition of a second light source would provide more light to the sign. Therefore, the combination is proper and the claim is not allowable.

Appellant goes on to argue that the Examiner has provided no explanation to support the combination of Easterday and Ashall. This explanation has been provided. The motivation to combine the references is "for providing additional light" (page 3 of the Final Rejection). As noted in Appellant's brief, Ashall discloses the use of two light sources for larger signs (column 3, line 16). Ashall suggests that using a second light source would provide more light. Thus, Ashall does suggest the combination, and the rejection is proper.

Appellant also maintains that claim 1 is allowable because the present invention maximizes the use of all available light rays. However, this feature of the invention has nothing to do with what is in the claim. For the reasons specified earlier the limitations of the specification should not be read into the claims.

Appellant also argues that the addition of two properly angled sides and the "dimensional relationship" between the box and the lamp diameters disclosed in the instant application renders claim 1 patentable (Corrected Appeal Brief, page 12). However, these features do not appear in claim 1. For the reasons disclosed in the rejection of the claim Easterday and Ashall disclose the elements of claim 1, rendering claim 1 unpatentable.

Claim 2

Appellant argues that it would not be obvious to decide the thickness of the box. To the contrary, deciding the thickness of the box according to the thickness of the lamp is within the knowledge of one of ordinary skill in the art. (The lamp is inside the box.) The fact that the box's width is approximately 1 inch larger than the diameter of either lamp is not in the specification, even though it has been argued extensively. Furthermore, the relationship between the size of the lamp and the size of the box is not in claim 2.

Claim 3

Appellant argues that although Ashall discloses the two plastic sheets of claim 3, the claim must be allowable because the sheets serve a different purpose. To the contrary, apparatus claims must differentiate from the prior art in terms of structure and not of function. See M.P.E.P. 2114. The structure of claim 3 is disclosed or suggested in the combination of Easterday and Ashall, and the claim is not allowable.

Claim 4

Appellant argues that since the Appellant's light-directing panel has a different structure than the light-directing panel of Easterday, claim 4 should be allowed. To the contrary, the differences alleged by the Appellant do not appear in the claim. As stated earlier limitations in the specification should not be read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim 5

Appellant argues that since the light-directing panel of Easterday has only two sides that reflect light, as opposed to the four sides disclosed in the Appellant's *specification*, the claim should be allowed. To the contrary, claim 5 only requires that the light-directing panel have four sides. The function of the sides does not matter, since the claim must differentiate itself from the prior art in terms of the structure and not the function of the elements. See M.P.E.P. 2114. Easterday discloses the light-directing panel having four sides as required in the claim. The use of the sides is immaterial to the allowability of the claim.

Appellant goes on to argue that Ashall does not work, because no direct rays contact the desired faces. To the contrary, the light from the top half of the light source in Ashall emerges in all directions from 0 degrees with the supporting surface to 180 degrees with the supporting surface. Some of the light is at an angle that it would hit the desired face. Even if the Appellant's assertion were true, it would not matter. The Appellant has effectively asserted that since the Appellant's invention is better than Ashall, the claims should be allowed. However, it is the wording of the claims that matters; one cannot read in limitations from the specification for

the reasons specified above. Nevertheless, Ashall's apparatus is designed to work properly, a fact which has been determined by the Examiner of Ashall.

Claim 6

Appellant essentially argues that it is not possible that Ashall's transparent sheet directs light towards the display signs. For the reasons disclosed in the analysis of claim 5, it does. Furthermore, Appellant has not shown that Ashall fails to disclose the elements of claim 5. The claim must differentiate itself over the prior art in terms of the structure recited by the claim and not the function of the elements. See M.P.E.P. 2114.

Claim 7

Appellant argues that since the shape and positioning of Easterday's light-directing panel is different from the Appellant's, the claim should be allowed. None of the differences asserted in the Appellant's argument appear in the claims. Limitations from the specification should not be read into the claims for the reasons specified above, and the claim is not allowable.

Claim 9

Appellant argues that the since the invention described in the Appellant's *specification* is different, the claim should be allowed. Claim 9 does not require that the distance between the middle of the display signs be the same as the distance as that from the sides of the display signs. Easterday et al. discloses the elements of the claim for the reasons given in the rejection. Limitations in the specification should not be read into the claims for the reasons given above.

Appellant also argues that since the use of a second light source in Ashall is only for very large signs, the claim should be allowed. The Appellant is really admitting that Ashall discloses a second light source, which is what is required by the claim. Nothing in the claim requires a small sign.

Claim 10

Appellant argues that since the structure of the display sign panels of the Appellant's *specification* is different, the claims should be allowed. To the contrary, the requirement that the sign panel cover the whole box is not in the claim. Limitations from the specification should not be read into the claims for the reasons discussed above.

Claim 11

Appellant argues that Easterday gives no evidence that the light source would be as tall as the vertical side or as wide as a horizontal side. To find the evidence in Ashall that the sign would be as wide as the horizontal side, one only needs to look at Fig. 1. The light source on the bottom is as wide as the sign. Per M.P.E.P. 2125 drawings can be used as prior art "for what they reasonably disclose and suggest to one of ordinary skill in the art."

Appellant argues that since Ashall indicates that the second light source should only be used with a larger sign, it should be ignored. Nothing in the claim requires a small sign, and the Appellant is really admitting that Ashall discloses a second light source.

Claim 12

Appellant argues that since Easterday does not discuss the angle formed by the two sheets of the light-directing panel, the claim should be allowed even though the angle of the

sheets has nothing to do with the elements of the claim. Again, the Appellant wants the Examiner to read in limitations from the specification into the claims. This is not permissible for the reasons discussed above.

Claim 13

Appellant's argument is not clear for claim 13. Since the argument indicates that the Appellant's reason that claim 13 should be allowed is similar to that of claim 12, the argument for claim 13 should fail, because the argument for claim 12 should fail for the reasons specified above. Furthermore, for the reasons discussed in the analysis of claim 11 Ashall suggests using a panel that is the same height (or width) of the lamp.

Claims 14, 15 and 16

Appellant again argues that since the Appellant's invention has an element (in this case a parabolic reflector) that is not in the prior art the claim should be allowed. To the contrary, the claims do not require a parabolic reflector. Limitations in the specification cannot be read into the claims for the reasons specified above.

Claim 15

Appellant argues that since the Appellant's invention works better than the prior art, the claims should be allowed. However, as repeatedly asserted in this brief, the structure of the present invention has to differentiate itself from the prior art in terms of structure. See M.P.E.P. 2114. Furthermore, the claim specifies an at least partial reflector, which is what is shown in Easterday. Claim 15 is rendered obvious and is not patentable.

Claim 17

Appellant argues that since the Appellant's circuit is different from the prior art circuit, the claim should be allowed. Nothing in the claim requires any specific type of circuit. Again, limitations in the specification should not be read into the claims for the reasons specified above. Furthermore, claims should be interpreted broadly. See M.P.E.P. 2111. Therefore, the wire that connects the lamp to the plug is electrical circuitry, and the claim is rendered obvious.

Claim 19

Appellant argues that since Ashall only uses the second light source in large signs the suggestion of the second light source should be ignored. Appellant, again, is really admitting that Ashall discloses a second light source as required by the claim. Appellant also argues that since the structure of the Appellant's *invention* is different from the prior art, the claims should be allowed. Again, as specified above, this is not the case. Limitations in the specification should not be read into the claims for the reasons specified above. Claim 19, therefore, is rendered obvious.

Summary of Issue 1

The Appellant goes to a great deal of trouble to say that the Appellant's invention is different and the subject matter of Ashall does not work. For the reasons disclosed in the analysis of claim 5, the invention of Ashall does work as determined by the Examiner of Ashall. Furthermore, the differences asserted by the Appellant simply do not appear in the claims. Limitations in the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Issue 2—Whether claim 8 is unpatentable over Easterday et al. in view of Ashall as applied to claims 4 and 5 and further in view of Murase et al. under 35 USC 103(a)?

Claim 8


Appellant argues that since the specification stresses that the distance between the light sources should not be greater than 0.6 to 0.65 of the length of the light sources, the claim should be patentable. To the contrary Murase et al. discloses this feature in Fig. 6. According to the M.P.E.P. “[t]he drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 USPQ 500 (CCPA 1979).” See M.P.E.P. 2125. Furthermore, a recitation of relative dimensions by itself fails to make a claim allowable if the prior art apparatus “would not perform differently. . . .” See M.P.E.P. 2144.04. Since the drawings can be used as prior art, the element of claim 8 is met, and the claim is unpatentable.

Art Unit: 2875

Conclusion

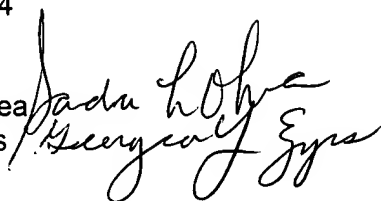
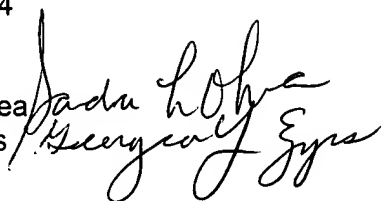
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Stephen Husar
Primary Examiner

sep
June 16, 2004

Conferees
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